

REMARKS

This paper responds to the Decision on Appeal communicated September 17, 2009. Claims 12-13 and 16-20 are amended herein. No claims are canceled, and no claims are added. As a result, claims 1-30 remain pending in this application.

§ 112 Rejections of the Claims

Claims 12-20 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. According to the MPEP:

When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.¹

Furthermore, even “a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is **discernible**.”² Applicants respectfully submit that the language of claims, as amended herein, is discernible and hence not indefinite under § 112, second paragraph.

The Decision on Appeal stated that “[c]laims 13-20 depend from claim 12 and therefore, inherit the ambiguity of claim 12 above, as describe[d] in the rejection of claim 12 . . . on page 4 of the [Examiner’s] Answer [communicated October 2, 2007].”³ Specifically, the Examiner’s Answer stated that “the language in the claim does not particularly point out and distinctly claim whether the listings are hosted by the network between popularity boundaries or whether the

¹ MPEP 2173.02, first paragraph, emphasis in original.

² *Id.* at fourth paragraph, citing *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 U.S.P.Q.2d 1996, 1999-2000 (Fed. Cir. 2004) (holding that the disputed claim term “surrender value protected investment credits” which was not defined or used in the specification was **discernible and hence not indefinite** because “the components of the term have **well recognized meanings**, which allow the reader to infer the meaning of the entire phrase with reasonable confidence,” emphasis added).

³ Decision on Appeal, page 12.

popularity boundaries are derived as a result of their association with the identified term.”⁴ The Examiner’s Answer further stated that “[i]t cannot be determined whether the listings are initially located between popularity boundaries on the network that are then associated with the identified term, or whether the listings are on the network independently of popularity boundaries with the popularity boundaries derived later via their relationship with the identified term.”

Claim 12 is amended herein to omit recitation of “**locating** listings” and to recite, in part, “**identifying** listings hosted by the network-based commerce system, the identifying of the listings being based on an upper popularity boundary and a lower popularity boundary”⁵ Subject matter support for this amendment may be found in Applicants’ specification, for example, at paragraph 00056.⁶ Applicants respectfully submit that, as amended herein, the language of claim 12 and its dependent claims 13-20 is **discernible** and hence not indefinite under § 112, second paragraph. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

⁴ Examiner’s Answer, page 4.

⁵ Claim 12.

⁶ Specification, paragraph 00056, “all listings between the relative lower popularity boundary 210 and relative upper popularity boundary 212 of the retrieved term-category pair are searched to locate listings identified by the term-category pair (. . . a popular search term that has been identified . . .).”

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4048 to facilitate prosecution of this application.


If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendments, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 11th day of November, 2009.

Chris Bartl
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Signature